

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KENICHI HIGASHI
AND YOUSUKE TSUKUDA

Appeal 2007-1004
Application 09/842,248
Technology Center 1700

Decided: May 23, 2007

Before EDWARD C. KIMLIN, CHUNG K. PAK, and PETER F. KRATZ,
Administrative Patent Judges.

KRATZ, *Administrative Patent Judge.*

DECISION ON APPEAL

This is an appeal from the Examiner's final rejection of claims 1-19.
We have jurisdiction pursuant to 35 U.S.C. §§ 6 and 134.

Appellants' claimed invention is directed to a laminated film comprising two resin layers, a structure including such a laminated film, and a method for forming the structure. The structure can be used in making car parts and household electrical appliance parts. One laminate layer includes an acrylic resin and another laminate layer includes a propylene polymer, a thermoplastic elastomer, and a filler. Claim 1 is illustrative and reproduced below:

1. A laminated film comprising:

(i) a resin layer (A) containing an acrylic resin, and

(ii) a resin layer (B) containing a resin composition, which composition comprises:

(a) 10 to 98% by weight of a propylene polymer,

(b) 1 to 60% by weight of an inorganic filler, and

(c) 1 to 60% by weight of a thermoplastic elastomer, provided that the sum of the components (a), (b) and (c) is 100% by weight.

The Examiner relies on the following references as prior art evidence in rejecting the appealed claims:

Spain	US 5,725,712	Mar. 10, 1998
Saeki	US 5,829,804	Nov. 3, 1998

Claims 1-19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Spain in view of Saeki.

At the outset, we note that Appellants argue the rejected claims as a group rather than separately. Thus, we select claim 1 as the representative claim on which we shall decide this appeal.

The Examiner has found that Spain discloses a multilayer laminate including acrylic in one layer and backing sheet and substrate layers, the latter layers being formable from a variety of resins or plastic materials, including thermoplastic polyolefin (Answer 3-4).¹ The Examiner has found that Saeki discloses a resinous composition including propylene resins and fillers useful in forming automobile body parts, including bumpers (Answer 4-5). The Examiner essentially asserts that it would have been obvious to one of ordinary skill in the art at the time of the invention to employ the resin composition of Saeki as the resinous material used in forming the backing sheet layer and/or a substrate layer of the laminate product of Spain for improved impact strength and/or surface quality of the product and in so doing arrive at a product embraced by representative claim 1 (Answer 5).

Appellants do not dispute that Spain discloses a laminate film product useful in forming automobile body parts, wherein one or more layers thereof comprises acrylate, which layer(s) corresponds to resin layer (A) of representative claim 1 (*See* the Brief in its entirety and Spain at col. 11, l. 11 – col. 12, l. 37 and col. 14, ll. 14-56).² Moreover, Appellants do not dispute that Spain discloses the use of a backing and a substrate layer which are

¹ Our references to the Answer herein are to the Examiner's Answer mailed September 29, 2006.

² Our references to the Brief and Reply Brief herein are to the Substitute Appeal Brief filed on November 17, 2005 and the Reply Brief filed on November 28, 2006.

laminated to the acrylate layers of Spain (*See* the Brief in its entirety and Spain at col. 16, l. 55 – col. 18, l. 19).

Rather, Appellants maintain that the Examiner's proposed combination of Spain and Saeki is in error as the modification proposed would not have been suggested to one of ordinary skill in the art at the time of the invention. Moreover, Appellants maintain that even if one of ordinary skill in the art would have combined the respective teachings of Spain and Saeki, the resultant combination would have, at best, resulted in the formation of a product that differs from the laminated film of representative claim 1.

Thus, the question before us is: Whether Appellants have demonstrated reversible error in the Examiner's proposed obviousness rejection by asserting a lack of suggestion or motivation to combine Spain and Saeki and/or by arguing that the resultant product obtained by one of ordinary skill in the art would not render the claimed subject matter obvious even if Spain and Saeki were combined?

We answer these questions in the negative and affirm the Examiner's obviousness rejection for essentially the reasons set forth in the Answer and below.

As for Appellants' argued lack of suggestion/motivation for the Examiner's proposed combination of Spain and Saeki, we observe that Spain teaches that the backing sheet and substrate can be made from compatible synthetic resinous materials that would allow for the injection molding of the substrate and thermoforming of the backing sheet for forming a shaped product (col. 16, l. 62 – col. 17, l. 7). Spain teaches that thermoplastic polyolefins can be used (col. 17, l. 23-28, col. 20, ll. 49-55, col. 33, l. 1 - col.

34, l. 14 and Example 13) . Thus, one of ordinary skill in the art would have recognized the clear direction in Spain to look to available prior art polyolefin-containing resinous materials, such as the resinous material of Saeki, for use in forming the backing sheet and substrate layers of Spain. *See KSR Int'l Co. v. Teleflex, Inc.*, 127 S.Ct. 1727, 1740-41, 82 USPQ2d 1385, 1396 (U.S. 2007); *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). Indeed, both Spain and Saeki are concerned with forming body parts for an automobile, such as a bumper. Further concerning this matter, we note that the substitution of one known bumper forming material for another would represent an obvious alternative that would be expected to be attended by a reasonable expectation of success by one of ordinary skill in the art.

We are mindful that Saeki discloses use of a filler as part of the resin composition disclosed therein. In this regard, Appellants essentially maintain that Spain would have taught away from one of ordinary skill in the art using a filler in the backing sheet (Reply Br. 2-3 and Br. 8-10 and 14). This argument is based on the disclosure in Spain that the substrate may include a substantial amount of filler and have an imperfect surface upon molding whereas Spain indicates the backing sheet acts as a buffer to isolate imperfections in the substrate from the surface coat (col. 17, ll. 2-36). This argument is not persuasive for several reasons. First, representative claim 1 requires as little as 1 weight percent filler and Appellants have not established such small amounts represent the substantial amount of filler that Spain notes as potentially resulting in surface imperfections on molding a substrate. Second, Appellants' position that Spain teaches substantial amounts of filler can be incorporated into the substrate, but not in the

backing sheet, is unavailing because the resin layer (B) of representative claim 1 is not required to be used in a laminate backing sheet layer, but just in a layer (B), a layer which encompasses the substrate layer of Spain. In this regard, the Examiner's position (Br. 5) that it would have been obvious to use the resin composition of Saeki in the substrate layer of Spain is not even addressed, much less called into question by this line of argument.

Appellants further argue that the Examiner's combination of Spain and Saeki would result in polyhydroxy polyolefin in the resin composition (Br. 11-12), which ingredient is allegedly not encompassed by representative claim 1. However, Saeki clearly teaches that the polyhydroxy polyolefin component (E) thereof is an optional ingredient. Thus, it is manifest that one of ordinary skill in the art would have recognized that the optional resin ingredient (E) can be omitted with the corresponding function thereof.

Also, Appellants' summarily presented "obvious to try" and "impermissible hindsight" contentions are off the mark and clearly without merit in establishing reversible error in the Examiner's rejection for reasons set forth above and in the Answer.

On this record, we affirm the Examiner's obviousness rejection.

CONCLUSION

The decision of the Examiner to reject claims 1-19 under 35 U.S.C. § 103(a) as being unpatentable over Spain in view of Saeki is affirmed.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2006).

AFFIRMED

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